

***Response to Amendment***

1. This action is in response to the amendment filed on February 19, 2008. Claims 1, 3-4, and 13-15 have been cancelled. Claims 5-12, and 16-19 have been withdrawn. Claim 2 and 20-21 have been amended. Claims 2 and 20-21 are pending examination.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2 and 20-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 2 and 20-21 recite "wherein the second candidates for purchase include the first candidate and other candidates", there is no support in applicant's specification for the recited limitation above. Appropriate correction is required by applicant.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 20-21 recite "storing said first search parameter and the entered value", and "wherein the second candidates for

purchase include the first candidate and other candidates", which renders the claims indefinite. For the purpose of examination, the claim language will be interpreted as best understood.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 2 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burge et al. US Patent No. (6,014,638) in view of Vatanen US Patent No. (6,237,093) and further in view of Welsh et al US Patent No. (6,757,691).

Burge et al. disclose an information presentation device Fig.1 in which a user terminal on a network that retrieves products or services comprising:

Accepting means (electronic shopping manager 84) for accepting a selection of a product or service that is included in said products or services that were retrieved based on a value entered by a user for a first search parameter of a first group search parameters (col. 5 line 56 raw data is collected by retrieving the specific products selected by the shopper) ; and parameter storage means (read as database 18) for storing said first search parameter and the entered value for the selected product or service as a first candidate for purchase (col.7 lines 1-38...information regarding products and services retrieved from the merchant database 22 which information includes navigational inputs text and mouse clicks

entered while navigating for a "selected product/service"; and user identification information that identifies said user terminal (user identifier (ID) col. 4 identifies user and is deemed the obvious variant of the an inputted ID.

Notwithstanding, Vatanen discloses tying a user profile to a unique identifying address of a terminal device to identify the user. It would have been obvious to one of ordinary skill in the art to modify Burge et al. to use the terminal ID of the user, the motivation being the elimination of the sign-in step of Burge et al.

8. Neither Burge et al. or Vatanen disclose "user reference request accepting means for accepting user reference requests from first group of computer terminals on said network parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals, and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal, information setting means for receiving from said provider terminal the designation of user identification information included in said first user identification information provided to said provider terminal, and product information settings for said designated user identification information; product information storage means for storing said designated user identification information, said first product, and the product information that was set; and information presentation means for receiving a purchase candidate reference request from a designated user terminal identified by said designated user identification information, extracting from said parameter storage

means candidates for purchase that correspond to said designated user identification information, extracting said product information set for said first product that is included in said candidates for purchase from said product information storage means, and providing the extracted candidates for purchase and said product information to said designated user terminal; wherein the second candidates for purchase include the first candidate and other candidates”.

However, Welsh et al. does disclose user request accepting means for accepting user reference requests from first group of computer terminals on said network (predictive content system 700 and expert 1206 accepts by monitoring reference requests e.g. click stream decisions); Welsh et al. further disclose user reference request parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals (PID associates a user with a subset of content categories, content manager matches content choices with the PID see col. 13), and search parameters that each of said first user terminals has set to said first product, and providing them to said provider terminal (based on this association, content system 700 presents a selection of content choices to the user col. 8, 62 et seq.) Welsh et al. further disclose information setting means (PID database 1104 col. 12 line 39) for receiving from said provider terminal the designation of user identification information included in said first user identification information provided to said provider terminal, and product information settings for said designated user identification

information (PID obviously includes settings of product information in order to be mapped to see col. 8 line 52); product information storage means for storing said designated user identification information (read as the PIDI data base which also receives the PID data where I indexes a profile), and presentation means (read also as the content system 700 which presents a selection of content choices to the user) for receiving a purchase candidate reference request from a designated user terminal identified by said designated user identification information and a second candidates for purchase include the first candidate and other candidates; Regarding the extracting device portion, the identifier PIDI is referenced to a product information set and the user reads it on the extraction functions and these users identified by the suffix I are or can be presented as a group given the old and notorious use of a sorting function in computers. It would been obvious to one of ordinary skill in the art to modify the system of Burge et al. with the grouping feature of Welsh et al. as described above, the motivation being the ability to categorized groups of users or people who like a certain product for ease in mass marketing.

9. As per claim 20-21, the limitations of claims 20-21 contain similar limitations as in claim 2; therefore they are rejected based on the same rationale.

***Response to Arguments***

10. Applicant's arguments have been fully considered but are not persuasive. In Particular applicant argues:

**A)** The cited art, alone or in combination, does not teach a configuration where a product provider receives the user's navigational choices or a list of products in which the user is interested from a user.

In response to **A)** the examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Welsh et al discloses user request accepting means for accepting user reference requests from first group of computer terminals on said network (predictive content system 700 and expert 1206 accepts by monitoring reference requests e.g. click stream decisions); Welsh et al. further disclose user reference request parameter providing means for extracting from said parameter storage means a first user identification information identifying said first user terminals that have selected a first product as a candidate for purchase that is provided by an administrator of a provider terminal included in said first computer terminals (PID associates a user with a subset of content categories, content manager matches content choices with the PID see col. 13), and presentation means (read also as the content system 700 which presents a selection of content choices to the user) for receiving a purchase candidate reference request from a designated user terminal identified by said designated user identification information regarding the *extracting device portion*, the identifier PIDI is referenced to a product information set and the user reads it on the extraction functions and these users identified by the suffix I are or can be presented as a group given the old and notorious use of sorting function in computers. Therefore Burge et al in view of Vatanen and in further view of Welsh et al., still meet the scope of the limitations as currently claimed.

**B)** Applicant contends that there is no motivation to combine Burge in view of Vatanen, and further in view of Welsh.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would be extremely advantageous to incorporate the teachings of Vatanen into the disclosure of Burge et al., to use the terminal ID of the user, the motivation being the elimination of sign-in step of Burge et al. Also it would be advantageous to incorporate the teachings of Welsh et al into the disclosure of Burge et al in view of Vatanen, the motivation being the ability to categorize groups of users or people who like a certain product for ease in mass marketing. Therefore, in view of the above evidence, the combination of Burge in view of Vatanen, and further in view of Welsh still meet the scope of the limitations as currently claimed.

In addition, the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally, it is noted that KSR forecloses the argument that a **specific** teaching, suggestion, or motivation is required to support a finding of obviousness. Under KSR, a claim would have been obvious if the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art at the time of the invention. Furthermore, under KSR, a claim would have been obvious if a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying the teachings of Vatanen and Welsh into the disclosure of Burge and the results would have been predictable to one of ordinary skill in the art.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUSSA A. SHAAWAT whose telephone number is (571)272-2945. The examiner can normally be reached on Mon-Fri (8am-5:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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